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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/514,759	02/28/2000	John Vivian Wood	SWIN 2012	9358

7812 7590 02/15/2005

SMITH-HILL AND BEDELL  
12670 N W BARNES ROAD  
SUITE 104  
PORTLAND, OR 97229

EXAMINER
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THALER, MICHAEL H

ART UNIT	PAPER NUMBER
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3731

DATE MAILED: 02/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/514,759	<b>Applicant(s)</b> WOOD ET AL.	
	<b>Examiner</b> Michael Thaler	<b>Art Unit</b> 3731	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 02 February 2005.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 53-55, 57-66 and 68-75 is/are pending in the application.
- 4a) Of the above claim(s) 64-66 and 68-75 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 53-55 and 57-63 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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Claims 64-66 and 68-75 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made by original presentation. As to new process claim 75, the product (claims 53-55 and 57-63) as claimed can be used in a materially different process of using that product. For example, it could be used by gripping an article when the gripping element is at a temperature above the martensite to austenite phase transition temperature.

Claims 53, 55, 57, 59 and 61-63 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Bendel et al. (5,242,458). Bendel et al. show a biocompatible gripping device for surgical use including at least one deformable gripping element (at I) comprising shape memory material (col. 3, lines 55-63). During its intended use, the gripping element I returns to its non-deformed condition after releasing the article as indicated in col. 3, lines 61-63. However, the gripping element is inherently capable of being used in a cold environment (below the martensite to austenite phase transition temperature), and when so used would inherently remain in its deformed condition after releasing the article since it would be in the martensite phase. Further, it would inherently return to its non-deformed

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condition upon heating (to room temperature, for example) since heating it would change its state from the martensite to austenite. Since the rejected claims are apparatus claims rather than method of use claims and since the Bendel et al. device is inherently capable of being used as claimed, the rejection is proper. Alternatively, it would have been obvious that the deformable gripping element (at I) requires to be heated to a temperature above the martensite to austenite phase transition temperature to return it to the non-deformed condition for the reasons set forth above.

Claims 54, 58 and 60 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bendel et al. (5,242,458). As to claim 54, Bendel et al. fail to disclose the specific phase transition temperature. However, it would have been obvious that the phase transition temperature of the nitinol gripping elements falls within the claimed range since they are in the austenitic phase at room temperature (since they apparently return to their original shape at room temperature as indicated in col. 3, lines 61-63) and since it is old and well known that the specific phase transition temperature of nitinol typically falls within the claimed range. As to claim 58, Bendel et al. fail to disclose the specific percentages of titanium and nickel. However, it is old and well known to use the claimed percentages

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for a nickel titanium alloy in order to obtain the desired shape recovery. It would have been obvious to use the claimed percentages for the Bendel et al. nitinol so that it too would have this advantage. As to claim 60, Bendel et al. fail to disclose the claimed attachment means. However, it is old and well known in this art to use attachment means such as soldering or riveting in order to positively secure an insert to a jaw. It would have been obvious to use the claimed attachment means for the Bendel et al. insert and jaw so that it too would have this advantage.

Applicant's arguments filed Feb. 2, 2005 have been fully considered but they are not persuasive for the reasons set forth above. Apparatus claim 53 requires the gripping element to have an austenitic phase and a martinsitic phase. The Bendel et al. gripping element inherently has an austenitic phase and a martinsitic phase. The intended use of gripping an article when the gripping element is in the martinsitic phase is given no patentable weight since the Bendel et al. device is inherently capable of being used as claimed. The Bendel et al. device, with no structural modifications, is inherently capable of being put into a cold environment and then used to grip an article to deform the gripping element such that only upon heating (to room temperature) would it return to the non-deformed condition.

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**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Thaler whose telephone number is (571)272-4704. The examiner can normally be reached Monday to Friday.

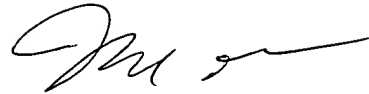
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anhtuan T. Nguyen can be reached on (571)272-4963. The fax phone number for the organization where this application or proceeding is assigned is (703)872-9306.

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2/14/05

A handwritten signature in black ink, appearing to read 'Michael Thaler', with a stylized flourish at the end.

MICHAEL THALER  
PRIMARY EXAMINER  
ART UNIT 3731